REMARKS

In response to the Office Action dated December 16, 2005, the Assignee respectfully requests reconsideration based on the following remarks. The Assignee respectfully submits that the pending claims already distinguish over the cited documents.

The United States Patent and Trademark Office (the "Office") objected to claim 34 for informalities. Claims 43-47, 49-50, and 52 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,732,366 to Russo. Claims 1-3, 5, 8-9, 12-19, 23-33, and 36 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of U.S. Patent 5,790,176 to Craig. Claims 4, 20, 34, and 37-42 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of *Craig* and further in view of Published U.S. Patent Application 2002/0118954 to Barton *et al.* Claims 6-7 and 10-11 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of *Craig* and further in view of U.S. Patent 6,141,488 to Knudsen *et al.* Claims 48 and 53 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo*. The Assignee shows, however, that the pending claims are neither anticipated nor obviated by the cited documents. The Assignee thus respectively submits that the pending claims already distinguish over the cited documents.

Objection to Claim 34

The Office objected to claim 34 for informalities. Claim 34 has been amended to cure the informality.

Rejection under 35 U.S.C. § 102

Claims 43-47, 49-50, and 52 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,732,366 to Russo. A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition)

(hereinafter "M.P.E.P."). As the Assignee shows, claims 43-47, 49-50, and 52 recite features not disclosed by *Russo*. The patent to *Russo* does not anticipate the claims, so the Assignee respectfully requests that Examiner Lambrecht to remove the 35 U.S.C. § 102 (e) rejection.

Claims 43-47, 49-50, and 52 are not anticipated. These claims recite, or incorporate, features not disclosed by *Russo*. Independent claim 43, for example, recites receiving "*digital information including a storage position identifier from a service provider for each multimedia content item, the storage position identifier specifying a logical storage position for the multimedia content item, the storage position identifier updated by the service provider.*" Because this feature distinguishes over *Russo*, and because this feature is already recited in claims 4, 20, 34, and 37, Examiner Lambrecht has no cause for a final rejection in the next office action. Claim 43, for example, is reproduced below.

> 43. (Currently Amended) An apparatus for selecting multimedia on demand, comprising:
>
> a data switch interface coupled to a switch port of a data switch, the data switch interface selecting and receiving digital information from a plurality of multimedia sources, the digital information including a storage position identifier from a service provider for each multimedia content item, the storage position identifier specifying a logical storage position for the multimedia content item, the storage position identifier updated by the service provider;
>
> a processor for controlling selection of information via the data switch interface; and
>
> processing logic for processing the received digital information for output.

Russo does not anticipate claims 43-47, 49-50, and 52. *Russo* fails to teach or suggest "*digital information including a storage position identifier from a service provider for each multimedia content item, the storage position identifier specifying a logical storage position for the multimedia content item, the storage position identifier updated by the service provider.*" Because *Russo* is silent to at least these features, the patent to *Russo* cannot anticipate the claims. The Assignee, then, respectfully requests that Examiner Lambrecht remove the § 102 rejection.

Rejection of Claims under 35 U.S.C. § 103 (a) over *Russo & Craig*

Claims 1-3, 5, 8-9, 12-19, 23-33, and 36 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of U.S. Patent 5,790,176 to Craig. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Claims 1-3, 5, 8-9, 12-19, 23-33, and 36 are not obvious. These claims recite, or incorporate, features not taught or suggested by *Russo* and *Craig*. Independent claim 1, for example, recites "*the multimedia-on-demand instructions including instructions to automatically receive the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second.*" Neither *Russo* nor *Craig* teaches this feature. Examiner Lambrecht is correct — *Craig* discloses a media server that can operate in "real-time, faster than real-time or slower than real-time." U.S. Patent 5,790,176 to Craig (Aug. 4, 1998) at column 11, line 66 through column 12, line 2. Yet *Craig* is silent to "*instructions to automatically receive the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second.*" The patent to Craig discusses a media server that sends (or "feeds") programs in "real-time, faster than real-time or slower than real-time." *Id.* at column 11, line 60 through column 12, line 2. As Examiner Lambrecht must realize, however, sending data fast or slow is entirely different from "*automatically receiv[ing] the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second.*" Claim 1, for example, is reproduced below.

1. (Previously Presented) A system for multimedia on demand, the system comprising:

a mass storage device, the mass storage device adapted to receive and store a multimedia content item;

a processor, the processor coupled to the mass storage device; and

a memory, the memory coupled to the processor, the memory storing a multimedia-on-demand data table and multimedia-on-demand instructions, the multimedia-on-demand data table including

a multimedia content identifier field to store a multimedia content identifier, the multimedia content identifier to correspond to a multimedia content item stored on the mass storage device, and

a multimedia content usage indicator field to store a multimedia content usage indicator, the multimedia content usage indicator associated with the multimedia content item stored on the mass storage device,

the multimedia-on-demand instructions to be executed by the processor, the multimedia-on-demand instructions including instructions to

automatically receive the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second, and

send a multimedia-on-demand usage message, the multimedia-on-demand usage message based at least in part on the multimedia content usage indicator.

Claims 1-3, 5, 8-9, 12-19, 23-33, and 36, then, are not obvious. The proposed combination of *Russo* and *Craig* is silent to "*instructions to automatically receive the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second.*" Because the proposed combination of *Russo* and *Craig* fails to teach or suggest at least these features, one of ordinary skill in the art would not think the claims are obvious. The *prima facie* case for obviousness, then, must fail. Examiner Lambrecht is thus respectfully requested to remove the § 103 rejection.

Rejection of Claims under 35 U.S.C. § 103 (a) over *Russo, Craig & Barton*

Claims 4, 20, 34, and 37-42 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of *Craig* and further in view of Published U.S. Patent

Application 2002/0118954 to Barton *et al.* First, claims 4, 20, 34, and 37 are dependent upon their respective base claims and, thus, incorporate the same distinguishing features. Claim 4, for example, incorporates the feature "*instructions to automatically receive the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second.*" Claims 20, 34, and 37 incorporate similar distinguishing features. Because the proposed combination of *Russo*, *Craig*, and *Barton* fails to teach or suggest at least these features, one of ordinary skill in the art would not think claims 4, 20, 34, and 37 are obvious.

Moreover, *Russo*, *Craig*, and *Barton* fail to teach or suggest other features. Claim 4, for example, recites "*a storage position identifier for each multimedia content item, the storage position identifier specifying a logical storage position for the multimedia content item, the storage position identifier received from a service provider and updated by the service provider with each change in the multimedia-on-demand data table.*" The proposed combination of *Russo*, *Craig*, and *Barton* is entirely silent to such features. The Assignee has reviewed the published document to Barton *et al.*, and the evidence does not support the rejection.

Barton fails to support the *prima facie* case. Examiner Lambrecht points to paragraphs [0210] through [0217] of *Barton*, but the evidence does not support the rejection. These paragraphs are entirely silent to a "*storage position identifier ... received from a service provider.*" These paragraphs discuss generating "specialty aggregation objects" by "extracting information of interest from each viewing object" and then "constructing a table of programs and attributes." Published U.S. Patent Application 2002/0118954 to Barton *et al.* (Aug. 29, 2002) at paragraphs [0210] through [0211]. "Aggregates [may] be based on events, such as a major league football game in a large city." *Id.* at paragraph [0213]. "Aggregates [may] be based on persons of common interest." *Id.* at paragraph [0214]. "Aggregates [may] be based on viewing behavior." *Id.* at paragraph [0215]. "Aggregates [may] be based on explicit selections by viewers." *Id.* at paragraph [0216]. The published application to Barton *et al.*, then, does not support Examiner Lambrecht's position. Because the proposed combination of *Russo*, *Craig*, and *Barton* fails to teach or suggest all the features of claims 4, 20, 34, and 37-42, one of

ordinary skill in the art would not think the claims are obvious. The *prima facie* case fails and the rejection must be removed.

Barton fails to support other portions of the *prima facie* case. Examiner Lambrecht also points to paragraph [0123], yet, again, the evidence does not support the rejection. This paragraph discusses software that chooses programs that may interest a viewer. This paragraph entirely fails to describe "*a storage position identifier for each multimedia content item, the storage position identifier specifying a logical storage position for the multimedia content item, the storage position identifier received from a service provider and updated by the service provider with each change in the multimedia-on-demand data table.*" Paragraph [0123] is reproduced below:

> [0123] 2. Application software may also directly process program guide objects to choose programs that may be of interest to the viewer. This process is typically based on an analysis of previously watched programming combined with statistical models, resulting in a priority ordering of all programs available. The highest priority programs may be processed in an application specific manner, such as recording the program to local storage when it is broadcast. Portions of the priority ordering so developed may be presented to the viewer for additional selection as in case 1.

Published U.S. Patent Application 2002/0118954 to Barton *et al.* (Aug. 29, 2002) at paragraph [0123]. This paragraph does describe how "highest priority programs may be processed in an application specific manner, such as recording the program to local storage when it is broadcast." This sentence, however, cannot reasonably be interpreted as the "*storage position identifier ... specifying a logical storage position for the multimedia content item, the storage position identifier received from a service provider and updated by the service provider with each change in the multimedia-on-demand data table.*" The evidence, then, does not support Examiner Lambrecht's position. Because the proposed combination of *Russo*, *Craig*, and *Barton* fails to teach or suggest all the features of claims 4, 20, 34, and 37-42, one of ordinary skill in the art would not think the claims are obvious. The *prima facie* case fails and the rejection must be removed.

Barton fails to support other portions of the *prima facie* case. Examiner Lambrecht also points to paragraphs [0219] and [0220], yet, again, the evidence does not support the rejection. These paragraphs discuss a feedback loop between a service provider and viewers. Paragraphs [0219] and [0220] are reproduced below:

> [0219] Clearly, aggregation program objects may also permit the expression of preferences or recording of other information. These results may be uploaded to the central site to form a basis for the next round of aggregate generation or statistical analysis, and so on.
> [0220] This feedback loop closes the circuit between service provider and the universe of viewers using the client device. This unique and novel approach provides a new form of television viewing by providing unique and compelling ways for the service provider to present and promote the viewing of television programs of interest to individuals while maintaining reliable and consistent operation of the service.

Published U.S. Patent Application 2002/0118954 to Barton *et al.* (Aug. 29, 2002) at paragraphs [0219] and [0220]. These paragraphs, however, cannot reasonably be interpreted as the "*storage position identifier ... specifying a logical storage position for the multimedia content item, the storage position identifier received from a service provider and updated by the service provider with each change in the multimedia-on-demand data table.*" The evidence, then, does not support Examiner Lambrecht's position. Because the proposed combination of *Russo*, *Craig*, and *Barton* fails to teach or suggest all the features of claims 4, 20, 34, and 37-42, one of ordinary skill in the art would not think the claims are obvious. The *prima facie* case fails and the rejection must be removed.

Rejection of Claims under 35 U.S.C. § 103 (a) over *Russo, Craig & Knudsen*

Claims 6-7 and 10-11 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo* in view of *Craig* and further in view of U.S. Patent 6,141,488 to Knudsen *et al.* These claims, however, depend from independent claim 1 and, thus, incorporate the same distinguishing features. Claims 6-7 and 10-11, for example, all incorporate the feature "*instructions to automatically receive the multimedia content item at a transmission rate that is less than a real time transmission rate in bytes per second,*" as recited in independent claim 1.

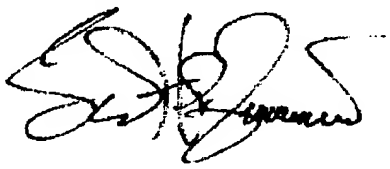
Because the proposed combination of *Russo*, *Craig*, and *Knudsen* fails to teach or suggest at least this feature, one of ordinary skill in the art would not think claims 6-7 and 10-11 are obvious. The *prima facie* case for obvious must fail, so Examiner Lambrecht is respectfully requested to remove the § 103 rejection.

Rejection of Claims 48 & 53 under 35 U.S.C. § 103 (a) over *Russo*

Claims 48 and 53 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Russo*. Because no claim "53" is pending, the Assignee will assume claims 48 and 52 are rejected. Nonetheless, claims 48 and 52 are dependent upon independent claim 43 and, thus, incorporate the same distinguishing features. Claims 48 and 52, for example, incorporate "*receiving ... a storage position identifier from a service provider for each multimedia content item, the storage position identifier specifying a logical storage position for the multimedia content item, the storage position identifier updated by the service provider.*" Because *Russo* fails to teach or suggest at least this feature, one of ordinary skill in the art would not think claims 48 and 52 are obvious. The *prima facie* case for obvious must fail, so Examiner Lambrecht is respectfully requested to remove the § 103 rejection.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or *scott@wzpatents.com*.

Respectfully submitted,



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